REMARKS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-20 have been rejected in the Office Action. No claims have been amended, no new claims have been added, and no claims have been canceled in this Response. Accordingly, claims 1-20 are pending herein. Claims 1-20 are believed to be in condition for allowance and such favorable action is respectfully requested.

Rejections based on 35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP § 2131.

Claims 1, 2, 4, 5, 7-10, 12-15, 17, 18, and 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0165701 A1 to Lichtenberg et al. (the "Lichtenberg reference"). As the Lichtenberg reference fails to describe either expressly or inherently, each and every element as set forth in the rejected claims, Applicants respectfully traverse this rejection, as hereinafter set forth.

Initially, independent claim 1 is drawn to a method in a computing environment for determining compatibility of parts in a selected product configuration. The method comprises determining whether a new part is compatible with one or more existing parts of the product configuration; and if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.

By way of contrast, the Lichtenberg reference discloses a method of configuring a product based on interdependencies of parts using a computer program to assist a user in making choices that lead to a consistent product. *See Lichtenberg reference* at Abstract. Rules relating to compatibilities between alternatives for different components may be represented in a Directed Acyclic Graph (DAG), which is used to determine whether selected alternatives are compatible with other components. *Id.* at paragraphs [0027] – [0034]. In some cases, if a user selects an alternative for a component that is incompatible with other components that have already been chosen, the system may provide information relating to the other components which are incompatible with the present selection. *Id.* at paragraphs [0102] – [0104]. The user may choose to keep the present selection and un-choose the incompatible components. *Id.* at paragraphs [105]. The Lichtenberg reference refers to this type of choice as a "forceable" or "forced" selection, meaning the selection may be made if the user is willing to undo some previous choices. *Id.* at paragraph [193]. The system will sacrifice/remove earlier selections that are incompatible with the current selection. *Id.* at paragraphs [0383], [0406] – [0412], and [0459].

It is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 1. In particular, the Lichtenberg reference fails to describe, either expressly or inherently, if a new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and the new part, as recited in independent claim 1. As indicated in the specification of the present application, if an incompatibility is determined to exist between an existing part and a newly selected part, the system determines a replacement part for either the existing incompatible part or the newly selected part. For example, with reference to FIG. 21a

and 21b, the specification of the present application discusses an exemplary method in which the system provides replacements for incompatible parts. For instance, as indicated at step 2122 in FIG. 21a and the corresponding discussion, if a new part is determined to be incompatible with a base part of the product configuration, the system provides an alternative for the new part. *See Specification*, page 59, line 22 through page 60, line 2; FIG. 21a. Additionally, as indicated at step 2130 in FIG. 21b and the corresponding discussion, if a new part is determined to be incompatible with an existing accessory part, the system provides a replacement part for the existing accessory part if one is available. *Id.* at page 60, line 19 through page 61, line 1; FIG. 21b. If a replacement part is not available for the existing accessory part, the system provides a replacement part for the new part. *Id.* at page 61, lines 5-8; FIG. 21b. Accordingly, in the claimed invention, the system determines a replacement part for either an incompatible existing part or a new part when a determination of incompatibility is made. In contrast, the Lichtenberg reference discusses simply removing a previous selection that is incompatible with a current "forced" selection. The reference fails to describe, however, that the system determines any replacements for the removed selections. Instead, presumably, the user would have to make a manual selection for each previous selection that was removed due to incompatibility. Accordingly, the Lichtenberg reference lacks any description, express or inherent, of determining a replacement part for either an existing part or a new part if the new part and existing part are determined to be incompatible.

As such, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element of independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35

U.S.C. § 102(e). Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 2, 4, 5, 7, and 8 depend directly or indirectly from independent claim 1, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejections to these claims as well.

Referring now to independent claim 9, a computer system capable of determining the compatibility of parts in a product configuration is recited. The computer system comprises a compatibility component which determines whether a selected part is compatible with existing parts of the configuration; and a replacement component which determines replacement parts for one of existing parts and new parts if a determination of incompatibility is made.

It is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 9. Particularly, the Lichtenberg reference fails to describe, either expressly or inherently, a replacement component which determines replacement parts for one of existing parts and new parts if a determination of incompatibility is made. This element is similar to the replacement part determining element discussed hereinabove for independent claim 1. Accordingly, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, this element of claim 9 for at least the reasons cited above for claim 1.

As such, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element of independent claim 9. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 9 under 35

U.S.C. § 102(e). Claim 9 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 10 and 12 depend directly or indirectly from independent claim 9, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejections to these claims as well.

Referring now to independent claim 13, a computer readable medium containing a data structure for storing part incompatibility information is recited. The data structure comprises a plurality of records in a table, each record including: at least two product identification values, said values representing that said products represented by said identification values are incompatible, and an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record.

It is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 13. Particularly, the Lichtenberg reference fails to describe, either expressly or inherently, a data structure comprising a plurality of records in a table, each recording including: (1) at least two product identification values, said values representing that said products represented by said identification values are incompatible; and (2) an indication as to product identification values which are suitable replacements for at least one of said product identification values entered in said record. As indicated in the specification of the present invention, each part is given a product identification number. *See Specification*, page 58, line 2. A part incompatibility table 2206, shown in FIG. 22, includes records having: (1) entries for two product identification

numbers, indicating that the parts corresponding with the two product identification numbers are incompatible; and (2) a replacement entry, indicating replacement parts for at least one of the two incompatible parts. In contrast, the Lichtenberg reference fails to describe, either expressly or inherently, anything similar to a table having such records, wherein each record includes an indication of incompatible parts and replacement parts for the incompatible parts. The Lichtenberg reference does discuss product tables. However, a product table, as used in the Lichtenberg reference, merely provides attributes for the various alternatives for a single component. *See Lichtenberg*, paragraphs [0242]-[0247]. While such product tables may provide information assisting in the determination of incompatibility, they do not anticipate the present claim as the tables do not include records, wherein each record includes (1) values indicating two or more incompatible parts and (2) values indicating replacement parts for the incompatible parts. The Office Action also refers to the Lichtenberg reference's discussion of the use of a DAG to represent rules regarding compatibility. However, it is respectfully submitted that a DAG is vastly different from a table having records, wherein each record includes (1) values indicating two or more incompatible parts and (2) values indicating replacement parts for the incompatible parts, such as that recited in independent claim 13. It should be noted that for a reference to anticipate a claim, "'[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." MPEP § 2131. Although the Lichtenberg reference discusses a DAG that may be used to represent rules regarding compatibility among components, in no way does this discussion show the identical invention in as complete detail as contained in independent claim 13.

As such, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element of independent claim 13. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 13 under 35 U.S.C. § 102(e). Claim 13 is believed to be in condition for allowance and such favorable action is respectfully requested.

Referring now to independent claim 14, a computer readable medium containing a method for determining compatibility of parts in a selected product configuration is recited. The method comprises determining whether a new part is compatible with one or more existing parts of the product configuration; and if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.

It is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 14. Particularly, the Lichtenberg reference fails to describe, either expressly or inherently, a computer readable medium containing a method that comprises determining a replacement part for one of an existing incompatible part and a new part if the new part is not compatible with one or more existing parts. This element is similar to the replacement part determining element discussed hereinabove for independent claim 1. Accordingly, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, this element of claim 14 for at least the reasons cited above for claim 1.

As such, it is respectfully submitted that the Lichtenberg reference fails to describe, either expressly or inherently, each and every element of independent claim 14. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 14 under 35

U.S.C. § 102(e). Claim 14 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 15, 17, 18, and 20 depend directly or indirectly from independent claim 14, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejections to these claims as well.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

The basic requirements of a *prima face* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". *See* MPEP § 2143. Further, in establishing a *prima face* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in

light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id. See also* MPEP § 706.02(j) and § 2142.

B. Rejections based on Lichtenberg

Claims 6, 11, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lichtenberg reference. Dependent claims 6, 11, and 19 depend directly from independent claims 1, 9, and 14, respectively. Accordingly, Applicants respectfully submit that dependent claims 6, 11, and 19 are patentable for at least the reasons stated above with respect to independent claims 1, 9, and 14. Moreover, there is no suggestion or motivation from the prior art to modify the Lichtenberg reference to achieve the invention of dependent claims 6, 11, and 19. Accordingly, Applicants submit that dependent claims 6, 11, and 19 are patentable over the Lichtenberg reference and respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 6, 11, and 19.

C. Rejections based on Lichtenberg and Forth

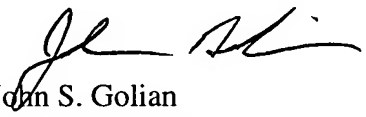
Claims 3 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lichtenberg reference in view of U.S. Patent No. 6,853,978 to Forth et al. (the "Forth reference"). Dependent claims 3 and 16 depend directly from independent claims 1 and 14, respectively, and the Office Action appears to rely on the Lichtenberg reference (and not the Forth reference) for the limitations from the base claims. Accordingly, Applicants respectfully submit that dependent claims 3 and 16 are patentable for at least the reasons stated above with respect to independent claims 1 and 14. Moreover, there is no suggestion from the prior art to combine the Forth reference with the Lichtenberg reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve the invention of claims 3 and 16. Accordingly, Applicants submit that dependent claims 3 and 16 are patentable over the

proposed combination of the Lichtenberg and Forth references and respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 3 and 16.

CONCLUSION

For at least the reasons stated above, claims 1-20 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1-20. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 21-0765.

Respectfully submitted,



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